

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/516,171

Atty. Docket No. Q58064

REMARKS

Claims 1 – 22 were previously pending. Claims 2 – 4 are herein cancelled, and claims 23 and 24 are added. Accordingly, claims 1 and 5 – 24 are presently pending.

Applicant submits that the subject matter of the presently amended claims has been before the Examiner since at least the Amendment under 37 C.F.R. § 1.111 filed on September 30, 2003. Because the subject matter of the amended claims has previously been before the Examiner, further search should not be required and entry of the instant Amendment is respectfully requested.

I. Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 1, 2, 7, 8, 10, 11 – 13, 18, 19, 21 and 22 under 35 U.S.C. § 103 as allegedly being unpatentable under Applicant's discussion of the related art in view of U.S.P. No. 5,090,028 to Crebouw. The Examiner also rejects claims 3, 4, 14 and 15 under 35 U.S.C. § 103 in view of Applicant's discussion of the related art, the Crebouw reference, and US 5,838,672 to Ranta.

Applicant herein cancels claims 2 – 4, and incorporates the subject matter of claims 2 – 4 into independent claim 1. The noted rejections are respectfully traversed as explained below.

A. Independent Claims 1 & 24

i. Prima Facie Obviousness Has NOT Been Established

The Examiner's combination of Applicant's Discussion of Related Art with the Crebouw and Ranta references fails to establish *prima facie* obviousness because the references fail to

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suggest the desirability of the combination. *N.B.* M.P.E.P. § 2143.01. This premise is explained below.

Applicant's claims 1 and 24 recite the selected subset comprising the 21st through 44th symbols, and the Examiner acknowledges (at page 8, approximately lines 8 – 9, of the instant Office Action) that both Crebouw and Ranta are deficient as to these features. There fails to be a suggestion of desirability to make the combination of Applicant's Discussion of Related Art with Crebouw and Ranta because even if one were able to make the combination the references fail to teach or suggest all of Applicant's recited features. *See* M.P.E.P. § 2143.01. Moreover, the mere possibility that the references might be combined fails to establish *prima facie* obviousness. *Id.* The Examiner is therefore respectfully requested to reconsider and withdraw this rejection.

ii. The Cited References Fail to Teach or Suggest All of the Features of Claims 1 and 24

The Examiner admits that Crebouw and Ranta are deficient in teaching or suggesting Applicant's recital of the selected subset comprising the 21st through 44th symbols of the training sequence, but nonetheless argues that these features are obvious. The Examiner's argument, however, rests solely on anecdote.

Applicant submits that M.P.E.P. § 2143.03 controls and requires that *all* claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness. Because Crebouw and Ranta fail to teach or suggest the features of the selected subset comprising the 21st through the 44th symbols of the training sequence, the instant rejection is deficient. The Examiner is therefore requested to reconsider and withdraw this rejection.

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iii. Further Evidence Required by M.P.E.P. § 2144.03(C)

To the extent that the Examiner considers any particular features of Applicant's claims to be officially noticed and/or common knowledge (that is, implicit in either of Crebouw or Ranta), the Examiner's attention is directed to M.P.E.P. § 2144.03(C), which provides that "[i]f Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner **MUST** support the finding with adequate evidence" (emphasis added).

Accordingly, Applicant submits that if the Examiner believes that the above-described features are implicit in either of Crebouw or Ranta, such a stance is not properly officially noticed and/or not properly based upon common knowledge. Therefore, if the Examiner believes that the noted features of claims 1 and 24 are implicit/common knowledge, the Examiner "**must** provide documentary evidence in the next Office Action if the rejection is to be maintained. If the examiner is relying on personal knowledge to support the finding . . . the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (emphasis supplied). Short of the Examiner withdrawing the rejection, the Examiner is respectfully directed to provide the evidence required by § 2144.03(C).

B. Independent Claims 12 and 23

The Examiner's analysis in the Office Action of September 30, 2004, overlooks the feature of deriving a frequency error estimate from the channel estimate by processing the channel estimate in conjunction *with a prior* training sequence. While the instant rejection compares Crebouw's Fig. 3, element 66, and associated text at col. 4, lines 6 – 14, to the above-

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noted features of Applicant's claims 12 and 23, it is respectfully asserted that any frequency error estimation made in the Crebouw device is made with a *present sequence and not a prior sequence*. The Examiner is therefore respectfully requested to reconsider and withdraw this rejection.

C. Dependent Claims 2 - 3, 5 - 11 and 13 - 24

Applicant submits that claims 2 - 3, 5 - 11 and 13 - 24 are patentable at least by virtue of dependency upon one of independent claims 1 and 12.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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MOUNTAIN VIEW OFFICE

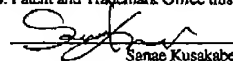
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CUSTOMER NUMBER

Date: December 9, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 9th day of December, 2004.


Senae Kusakabe